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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,274	12/21/2000	James C. Ashby III	5007-00700	3193

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EXAMINER

SMITS, TALIVALDIS IVARS

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/747,274

Applicant(s)
James C. Ashby III et al.

Examiner
Talivaldis Ivars Smits

Art Unit
2654



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 19, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. In response to the Office Action mailed November 14, 2002, applicants have submitted an Amendment (Amendment B), filed February 19, 2003, arguing to traverse the rejection of claims 5-39 for improperly recapturing subject matter. The response to applicants' argument follows.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive, for the following reason:

Applicants' argument that "no mention whatsoever was made about the recording means as being an element needed to gain issuance of the original patent" (Amendment B, p. 3) is contradicted by the Opinion of the Board of Appeals and Interferences on Brief, mailed July 31, 1997.

In discussing rejected original claim 22 (Patent claim 4) the Board counters examiner's assertion "Dittakavi teaches ... the claimed "recording means..." (his system inherently contains the recording in order that his bar code represents speech)" (Final Rejection, p. 6) by saying "Dittakavi's apparatus does not inherently include a voice recorder capable of recording a voice message as voice input...because the voice of the sender is not reproduced" (Opinion, p. 9).

Said "voice recorder" was listed as the second of three claimed limitations in the Board's analysis of claim 22 (Opinion, p. 8). Since the Board did not argue with examiner's assertion that the other two items were taught by Dittakavi, necessarily the only remaining limitation of the three, the voice recorder, caused the Board to not sustain this rejection.

Also, applicant's earlier Amendment A, filed August 22, 1994 emphasizes the importance of the said, admittedly originally claimed, voice recorder by adding to claim 22 the words "wherein said recording means comprises a voice recorder capable of recording said vocal message as telephone quality voice input" (p. 10).

Thus, the examiner concluded and still concludes that the omission of the voice recorder from the newly-claimed variations of original claim 22 (Patent claim 4) is improper recapture.

3. As for the "bar code label" (Amendment B, p.4), the examiner grants that applicant arguably has a valid point that the bar code label itself may not be required for allowance, but insists that the signal produced by a bar code reader definitely is needed for the allowance of said original claim. Since all the newly-added independent claims already recite a bar code signal, this issue can be considered moot.

4. Technically, newly-added independent claims 18, 24, and 35 do not recite a "telephone quality voice input" but only a "non-synthesized audio signal", which omission arguably broadens the above-cited limitation that was added by Amendment A to original claim 22, thus also comprising improper recapture, if the examiner wished to press this point. However, he does not,

since the "telephone quality" is defined in the Specification as "the original voice message recalled in a form substantially similar to the original form" (p. 6, lines 10-11), thus being non-synthesized.

5. Therefore the allowance of claims 1-4 and the rejection of claims 5-39 is repeated from the previous Office Action, *mutatis mutandis*, next.

Allowable Subject Matter

6. Claims 1-4 are allowed, because as claims 19-22 of the parent application 07/854,192, renumbered as claims 1-4, respectively, in U.S. Patent 5,852,803 they were deemed allowable, in response to applicants' arguments, over the prior art of record in the Decision on Appeal by the Board of Patent Appeals and Interferences, mailed July 31, 1997, for the following reasons (pages 6-9 of the Decision being herein summarized by the examiner):

Independent claim 1 (original claim 19 of parent application 07/854,192) is deemed allowable over Kondo in view of Tarlow because they do not teach nor fairly suggest a recordable releasibly secured product label which can be repetitively and reusably recorded. Dependent claims 2-3 (original claims 20-21) further limit claim 1 (original claim 19).

Independent claim 4 (original claim 22 of parent application 07/854,192) is deemed allowable over Dittakavi because he does not teach a voice recorder capable of recording a voice input and playing it back as a vocal message corresponding to a bar-coded label.

Claim Rejections - 35 USC § 251

7. New claims 5-39 are rejected under 35 U.S.C. 251 as being an improper recapture of

claimed subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ289, 295 (Fed. Cir. 1984).

None of the independent nor dependent claims include either (or both) of the limitations, cited above in the reasons for allowance under **Allowable Subject Matter**, which made the parent application's patented claims allowable. Specifically, claims 5-39 do not recite a voice recorder capable of recording a voice input and playing it back as a vocal message corresponding to a bar code label.

Applicants regarded inclusion of the voice recorder as constituting one of the two errors which this reissue application is supposed to correct. However, if a limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. Therefore, newly-added claims 5-39 are rejected as being improper recapture of surrendered subject matter for failing to recite a voice recorder.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any response to this action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or FAXed to:

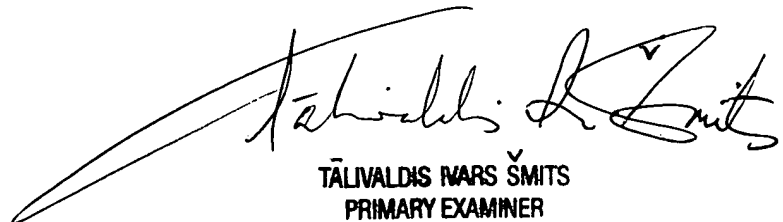
(703) 872-9314 (please label *official* communications
"EXPEDITED PROCEDURE"; please label *informal* or
draft communications "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-3011. The examiner can normally be reached Mondays-Fridays from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold, can be reached on (703) 305-4379. The facsimile phone number for Technology Center 2600 is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 customer service, whose telephone number is (703) 306-0377.



TĀLIVALDIS NARS ŠMITS
PRIMARY EXAMINER

Art Unit 2654
April 14, 2003